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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,976	05/30/2001	Yoshiki Kuraya	0230-0158P	5295
2292	7590	02/04/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HELMER, GEORGIA L	
			ART UNIT	PAPER NUMBER
			1638	
DATE MAILED: 02/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/856,976

Applicant(s)

KURAYA ET AL.

Examiner

Georgia L. Helmer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,9 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 August 2003 has been entered.

***Status of the Claims***

2. Applicant has cancelled claims 8, 10-12 and 14, and amended claims 1-4, 6, 9, and 13. Claims 1-7, 9 and 13 are pending, and are examined in the instant action.
3. All rejections not addressed below have been withdrawn.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. It is noted that Applicant has included reference articles with this Response. However, a proper submission of references must comply with 37 CFR 1.97 and include a filled-out PTO 1449 for consideration by the Office.

***Claim Rejections - 35 USC § 112 second***

6. Claims 2-7, 9, and 13 remain rejected under 35 U.S.C. 112, second paragraph; for reasons of record.

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Claim 2 remains rejected because it is unclear what function is associated with "recognized".

Applicant traverses, stating primarily (Response p. 7) that the term "recognize" is known in the art as a common word used to refer to the function of a protein, citing Sheng et. al. Plant Cell, 8: 1899-1710, 1996, who says that "vir proteins are known in the art to function together as an endonuclease".

Applicant's traversal has been considered and is unpersuasive. While "recognize" is a common word, it remains unclear what function would constitute "recognize". Without a more definite functional recitation, one skilled in the art would not be able to determine the metes and bounds of "recognize".

In claim 2 (d) insert after "wherein said vector", --when introduced into a plant--. It is unclear under what condition the vector reduces.

In claim 2(d), line 7, it is unclear to which vector "said vector" refers.

Claim 3 does not further limit claim 2. Since "more than one" encompasses "at least two".

- In claim 4, "gene" is unclear because a "gene" implies a DNA sequence that exists in nature and includes coding and noncoding regions, as well as all regulatory sequences associated with expression. Since this does not appear to be Applicant's intention, the language "a DNA of interest" is suggested. Or Applicant may recite the various components of the "gene" desired. All recitations of "gene" are also rejected.

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In claim 5, "a vector amplification bacteria cell" is unclear. What is an "amplification bacteria?"

In claim 6, how does the plant "cell" get to a "plant"?

***Claim Rejections - 35 USC § 112***

7. Claims 18-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejected subject matter is "vector amplification bacteria cell". Applicant is invited to point out the page and line number in the specification where "dedifferentiating" can be found. Absent such support, Applicant is required to cancel the new matter in response to this Office Action.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1-7, 9 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gartland in Methods in Molecular Biology Vol. 44, pages 15-28, 1995, Humana Press, Totowa NJ.

Gartland teaches a vector for Agrobacterium mediated plant transformation comprising a T-DNA left border region comprising more than one T-DNA left border sequence (p. 16, 2<sup>nd</sup> ¶, and p. 17, Figure 1 (B)). Since the method of Gartland is applied to the same plant population as in the instant case, and since the method of Gartland results in T-DNA transformation with no evidence for integration of any non-T-DNA segment in the plant chromosomes, the claimed invention is not distinguishable from method of Gartland.

Accordingly, Gartland anticipates the claimed invention.

#### **REMARKS**

10. No claim is allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 571-272-0976. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia Helmer  
Patent Examiner  
Art Unit 1638 – Transgenic Plants  
21 January 2004.



Amy Nelson for  
Phuong Bui

AMY J. NELSON, PH.D  
SUPERVISORY PATENT EXAMINER  
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